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In re Application of	:	
BOND, Thomas Eugene	:	
Application No.: 09/720,042	:	DECISION ON PETITION
PCT No.: PCT/AU99/00486	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 17 June 1999	:	
Priority Date: 17 June 1998	:	
Attorney Docket No.: 3113FBR	:	
For: SOFTWARE VERIFICATION AND	:	
AUTHENTICATION	:	

This is a decision on applicants' "Petition to Revive an Abandoned Application under CFR 1.137(b)" and "Response to Notification of Missing Requirements under 35 U.S.C. 371 and Petition under 37 CFR 1.183 to Suspend the Rules" filed 23 July 2002 in the above-captioned application. The requisite \$1320 petition fee for the filing of petition under 37 CFR 1.137(b) has been submitted and the requisite \$130 for a petition under 37 CFR 1.183 has been charged to Deposit Account 50-1290. The above-captioned national stage application became abandoned for failure to submit an acceptable oath or declaration within the time period set forth in the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) mailed 25 January 2001.

BACKGROUND

On 17 June 1999, applicant filed international application no. PCT/AU99/00486 which claimed a priority date of 17 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 December 1999. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States at midnight on 17 December 2000.

On 15 December 2000, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 25 January 2001, the PTO mailed a "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. The notification set a one-month period to respond.

On 26 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 25 January 2001 within the time period set therein.

On 23 July 2002, applicant filed the present petition.

DISCUSSION

A. Petition to Revive Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). The appropriate petition fee of \$1280 as set forth in 37 CFR 1.17(m) has been submitted. A terminal disclaimer is not required in this application.

With regard to Item (1), the proper response was the submission of the declaration of the inventor which complies with 37 CFR 1.497(a) and (b). Applicant states in the present petition, "it is not possible to have the original inventors execute a Declaration and Power of Attorney." Therefore, in order to comply with the proper reply requirement of item (1) above for revival under 37 CFR 1.137(b), applicant must submit a petition under 37 CFR 1.47(b). Under the present circumstances, in order for the response requirement, to be satisfied, the petition under 37 CFR 1.47(b) to accept the application without the signature of inventor Thomas Eugene Bond, must be grantable.

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

Therefore, applicants have not satisfied item (1) above.

Since applicants have not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

B. Petition Under 37 CFR 1.183

Under 37 CFR 1.183, "In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte,

or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in 1.17(h)."

In the present circumstances, applicants have not exhausted the remedies available to them. Applicants may file a petition under 37 CFR 1.47(b). Therefore, justice does not require a waiver of the rule where applicant has other means available to them for rectifying the abandoned status of the application. For this reason applicants' request for waiver is inappropriate.

CONCLUSION

For the reasons above, applicants' petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

Applicants' petition under 37 CFR 1.183 is DISMISSED without prejudice.

The application remains ABANDONED.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137 (b)."

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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